



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

ES

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/321,633	05/28/99	KENNEY	J E-1901

IM22/1117
JOSEPH M KONIECZNY
86 THE COMMONS AT VALLEY FORGE EAST
1288 VALLEY FORGE ROAD
P O BOX 750
VALLEY FORGE PA 19482-0750

EXAMINER

BEX, P

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 11/17/00

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/321,633

Applicant(s)

James W. Kenney

Examiner

Patricia Kathryn Bex

Group Art Unit

1743



☒ Responsive to communication(s) filed on May 28, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-34 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-34 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: #18 & 20 in Figs 1-7, #20a & 20b, # DS1, DS2, DC1, DC2, DP1, DP2 in Figs 1-7, #9 in Figs 3-4, #146 & 166 in Figs 8-9. Correction is required.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit:

Claim 1, line 17, the phrase "constructed and arranged" is indefinite. It is unclear as to how valve is "constructed and arranged" to selectively regulate the flow of air through the conduit.

Line 27, the term "generally" is not a positive recitation and renders the claim indefinite. Further, it is unclear as to what applicant means by the phrase "oriented generally, vertically downwardly". Same deficiency was found in claims 22 and 29.

Claim 6, line 2, recites the limitation "said attaching means". There is insufficient antecedent basis for this limitation in the claim.

Claims 11-13, the limitations; "DS1", "the prongs DP1", "the first fork", "the socket DS2", "the prongs DP2", DC1, DC2, and "the second fork" lack sufficient antecedent basis. It is not clear as to what DS1, DS2, DP1, DP2, DC1, DC2 are referring to. Same deficiency was found claims 25-27.

Claim 18, line 2, recites the limitation "said external air pressure source". There is insufficient antecedent basis for this limitation in the claim.

Claim 23, line 4, the phrase "constructed and arranged" is indefinite. It is unclear as to how first switch is "arranged and constructed" to activate/deactivate the air source.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit:

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-15, 22 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Columbus (USP 4,437,586).

Kenney teaches a pipette gun 17 having a remote source of air pressure 55 with an external flexible air conduit, a housing with hand grip portion, a barrel portion, a pipette connector 23 oriented transverse to the barrel portion 21, an internal conduit 61, a valve 31 intermediate the internal conduit, a positive 27 and negative 25 air flow trigger connected to the valve, and a switch 63 for regulating the flow of power to the remote air source (Fig. 1). Kenney fails to teach a gun holster arranged to support the gun above the work table. Columbus teaches a pipette holster use to support the pipette 10 above the work table in a vertical direction, comprising a base, a means for fastening the base to the vertical wall S, and mounting bracket 42 having a forks with prongs 46, 48 and circular sockets 50, 52 constructed to removably hold the pipette

Art Unit:

(Fig. 1). Such use of a bracket insures that the pipette tube does not touch anything and will remain sterile.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included in the dispensing means of Kenney, the pipette holster, as taught by Columbus, in order to insure that the pipette tube does not touch anything and will remain sterile.

With respect to the shape of the external conduit, it would have been obvious to one of ordinary skill in the art to coil a portion of the external conduit of Kenney, in order prevent most of the conduit from touching the table and possibly knocking over lab equipment on the table.

With respect to the specific fastening means it would have been an obvious matter of design choice to use suction cups, Velcro tabs or magnets. Since applicant has not disclosed that these specific fastening means solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the fixing means taught by Columbus.

8. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Columbus (USP 4,437,586), as applied to claim 1 above, and further in view of Nycum (USP 4,066,234).

Kenney and Columbus as discussed above, fail to teach a mounting pad for the air pressure source. Nycum teaches a universal mounting pad 11 with plurality of bores 28-29 for

Art Unit:

accepting structures 24-25 on equipment 10 and 30 (Figs. 1-2). Such a mounting pad is used for protecting fragile equipment against shock and vibration (abstract).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included in the dispensing means of Kenney and Columbus, the mounting pad, as taught by Nycum, in order to insure protection fragile pump equipment against shock and vibration.

9. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Nycum (USP 4,066,234).

Kenney as discussed above, fail to teach a mounting pad for the air pressure pump for a pipette gun. Nycum teaches a universal mounting pad 11 with plurality of bores 28-29 for accepting structures 24-25 on equipment 10 and 30 (Figs. 1-2). Such a mounting pad is used for protecting fragile equipment against shock and vibration (abstract). See reasons in previous rejection.

Allowable Subject Matter

~~10. Claims 16-17, 23-27 and 30 are allowable.~~

11. Claims 16-17, 23-27 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not teach or suggest a pipette gun holster which includes a first switch which

Art Unit:

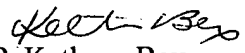
functions to deactivates the air source when the pipette gun is parked in the holster and to energize the air source when the pipette gun is removed from the holster.

Conclusion

13. No claims allowed.
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are Steele *et al*, Kenney ('871), Blakely, Kenney ('968), Mandell, Kenney ('147), Burg, Thiers. They are cited of interest in that they show various teachings of pipet gun assemblies. Mathis *et al*, and Steimen are cited of interest in that they show various teaching of mounting pads.
15. Any inquiry concerning this communication or earlier communications form the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697.

The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 for official papers prior to mailing of a Final Office Action. For official papers after mailing of a Final Office Action, use fax number (703) 305-3599. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


P. Kathryn Bex
Patent Examiner
AU 1743
November 15, 2000


ARLEN SODERQUIST
PRIMARY EXAMINER